

Remarks/Arguments

Claims 1-13 are pending in the application. Claims 1-13 are rejected because the Examiner considers them obvious under 35 USC §103(a). Applicant requests reconsideration of the rejections, which are based on a fundamental misunderstanding of the applicable legal principles, as well as technical details, as explained below.

It is important that the Examiner appreciate the problem addressed by the present invention so that it may be contrasted with the cited prior art. Conventional scheduling and calendaring systems (paper and PC based) are typically presented in tabular formats with activities scheduled in lines, boxes, or columns. For users, there is not immediate recognition of activities with times or dates, as the user must read and interpret the layout and associated scheduling information. The present invention recognized a need for simpler and quicker recognition of activities and dates. The inventor appreciating unforeseen advantages in dial faces for timepieces, which were considered by many as outmoded in favor of digital displays, arrived at the claimed combination of a dial face with graphical representations associated with time-of-day segments displayed on the dial face.

On the other hand, Hepp et al. is directed to a "non-static dial of a timepiece, where an animation of the dial is coupled with the seasonable progress of the time." (Col. 6, lines 12-15; claim 1.) The focus is on seasons, not time of day. There is no teaching or suggestion in Hepp et al. of any association of a scheduled activity with time-of-day segments so that a user can quickly visually perceive from the dial face what activities are scheduled for particular times of the day.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

All claims were rejected based on modification of Hepp et al. using alleged common knowledge of rearranging parts per *In re Japiske* and in view of Nixon (claims 2, 4, 6-7, 12-13) or in view of Narayanaswami (claims 9-11). The rejections based on Hepp et al. fail because the Examiner has not identified (1) all elements of the claimed invention in the cited prior art or (2) any teaching, motivation, or suggestion in the prior art for the claimed combination.

The 103 rejection of claims cannot be sustained because all elements of the claimed invention are not present in the prior art

Applicant's prior response identified specific teachings in Hepp et al. that character 15 cannot be considered a representation of a scheduled activity. In view of such teachings, the Examiner has not identified how character 15 can be characterized as a scheduled activity.

Assuming *arguendo* that character 15 does represent a scheduled activity, the rejection still fails. The Examiner has mischaracterized the application as claiming a "**scheduled activity 15 relative to a time of day display**". But this is not what claims 1-12 recite. What they do recite is "**a scheduled activity associated with a time of day segment**". The Examiner has not identified any teaching or suggestion for this arrangement, which provides the advantageous and novel solution to the problem addressed by this invention. (Claim 13

includes a slight variation of this language, and it too is patentably distinguishable over Hepp et al., for the same reason.)

The 103 rejection of the claims cannot be sustained because there is no evidence or rationale supporting the examiner's proposed modification of Hepp et al.

Claims 1, 5, and 8 were rejected based on modifications of Hepp et al. using supposed alleged common knowledge of rearranging parts per *In re Japiske*. (This reasoning is being used to support rejection of the other dependent and independent claims as well.) The Examiner acknowledges that Hepp et al. "does not explicitly teach a time of display [sic] segment located on the dial face." The Examiner then goes onto assert that "[i]t would have been obvious to a person skilled in the art . . . to adapt the dial face of the Hepp et al. reference to change the location of the graphical representation of the scheduled activity with a time of day segment from the outside of the dial face to the dial face itself since it has been held that rearranging the parts of the invention involves only routine skill in the art." The Board of Patent Appeals and Interferences, often citing authority from the Federal Circuit, has unequivocally rejected the *In re Japiske* case or not applied it in every¹ instance in which an Examiner has cited it to support the proposition for which the present Examiner is now citing the case. Representative cases are as follows (copies enclosed):

In re Chatillon, et al., 2001 WL 1339886 (Bd.Pat.App & Interf.)

"In further support of this rejection, the examiner has relied on In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950), urging that this case sets forth that as a general proposition "it has generally been recognized that the rearrangement of location of parts involves only routine skill in the art". . . .

In this regard, it is clear that the examiner has fallen victim to what our reviewing Court has called 'the insidious effect of a hindsight syndrome wherein that which

¹ Only once—and that was 50 years ago—has it been given any weight in supporting an argument of obviousness and that was for a different point of law. *Dalin v. Watson*, 204 F.2d 730, 92 U.S.App.D.C. 270

only the inventor has taught is used against its teacher.' W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

With regard to the examiner's use of a per se rule such as that derived from In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950), we direct the examiner's attention to In re Ochiai, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and In re Brouwer, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996) wherein the Court of Appeals for the Federal Circuit has held that the claimed invention as a whole must be evaluated under the standards set down in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), and its progeny, and that the use of per se rules is improper in applying the test for obviousness under 35 U.S.C. § 103 since such rules are inconsistent with the fact-specific analysis of claims and prior art mandated by section 103. Moreover, we also find that we are in agreement with appellants' treatment in the reply brief of the examiner's reliance on the Japikse case."

In re Kobayashi et al., 2001 WL 1057541 (Bd.Pat.App & Interf.)

"The examiner relies upon In re Japikse, 181 F.2d 1019, 1023, 86 USPQ 70, 73 (CCPA 1950), wherein the court considered shifting the position of a starting switch to not be a patentable distinction because such a change did not modify the operation of the device. The examiner has not established that changing the burner gas exit port height does not modify the operation of a glass melting furnace. The examiner has merely relied upon a per se rule that shifting the location of a part is prima facie obvious. As stated by the Federal Circuit in In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), 'reliance on per se rules of obviousness is legally incorrect and must cease.'"

In re Robles, et al., 1997 WL 1883840 (Bd.Pat.App. & Interf.)

"The examiner cites In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) for the general proposition that 'a mere shifting the location of parts' of an apparatus is a matter of obviousness for the skilled artisan (page 4 of Answer). However, our review of the case reveals no such proposition or rule of law. In relevant part, the court stated:

As to that limitation it was held that there would be no invention in shifting the starting switch disclosed by Cannon to a different position since the operation of the device would not thereby be modified. . . We think it is quite clear that Japikse is limited to the facts of the case, i.e., the position of the starting switch is immaterial and, therefore, obvious, since the overall operation of the device would not be affected by such change."

In re Yamamoto, et al., 2002 WL 31234526 (Bd.Pat.App & Interf.)

"Japikse, to the extent it is good law, is inapplicable to the present rejection . . .

'The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.'"

In re Brueggemann, 2002 WL 32102466 (Bd.Pat.App & Interf.)

"[T]he examiner takes the position that 'absent any criticality' this arrangement would have been obvious 'using routine experimentation since the courts have held that there is no invention in shifting the position of a structure to a different position if the operation of the device would not be thereby modified. In re Japikse, 86 USPQ 70 (CCPA 1950).' . . . We find this conclusion and the reasoning behind it to be untenable."

In accordance with the above citations are the following decisions: *In re Allen*, et al., 1999 WL 33226488 (Bd.Pat.App & Interf.); *In re McCrane*, 1998 WL 1736165 (Bd.Pat.App & Interf.); *In re Ziegler*, et al., 1996 WL 33103147 (Bd.Pat.App & Interf.); *In re Nakano*, 2002 WL 31321757 (Bd.Pat.App & Interf.); *In re Paul*, et al., 2002 WL 226977 (Bd.Pat.App & Interf.); *In re Fort*, 1997 WL 1884308 (Bd.Pat.App & Interf.); *In re Mangiagli*, WL 1990485 (Bd.Pat.App & Interf.); and *In re Afeyan*, et al., WL 519771 (Bd.Pat.App & Interf.)

In view of the applicable legal principles, it is incumbent upon the Examiner to show some teaching or suggestion in the cited references themselves. However, the cited prior art does not contain any such teaching or suggestion. The mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner's proposed modification of association character 15 with the dial would in fact be problematic because the animated nature of the character would visually interfere with the dial.

The MPEP 2144.03 dictates against exactly what has been done in this case:

“It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore. . . any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. “

The examiner's reliance on common knowledge or official notice is therefore improper and has been traversed.

Rejection of claims 2-4, 6-7 and 12-13 as obvious based on Hepp et al. in view of Nixon

Claims 2-4 and 6-7 depend directly or indirectly from claim 1. Applicant relies on the remarks made above as eliminating Hepp et al. as the primary reference used to reject these claims and claims 12-13. Therefore the rejection is traversed for the same reasons. Further, there is no teaching, suggestion, or motivation for the combination of Nixon with Hepp et al. Deficiencies in Nixon detailed in Applicant's response to the first Office Action, which are incorporated herein by reference. In particular, Nixon is a rate of progress indication; it does not have disclosure to scheduling of activities.

Rejection of claims 9-11 as obvious based on Hepp et al. in view of Narayanswami

Claims 9-11 depend directly or indirectly from claim 1. Applicant relies on the remarks made above as eliminating Hepp et al. as the primary reference used to reject these claims. Therefore the rejection is traversed for the same reasons. Further, there is no teaching,

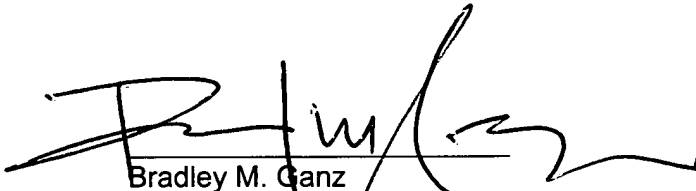
suggestion, or motivation for the combination of Hepp et al. and Narayanaswami under MPEP 2144.03.

CONCLUSION

Applicant submits that in view of the foregoing arguments and/or amendments, all rejections are traversed and the application is in condition for allowance, and favorable action is respectfully requested. The Commissioner is hereby authorized to charge any fees, including extension fees, which may be required, or credit any overpayments, to Deposit Account No. 50-1001.

Respectfully submitted,

Date: July 23, 2003



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